

### **REMARKS**

Claims 2 and 22 are cancelled without prejudice or disclaimer. Therefore, claims 1, 3-21, and 23-27 are the claim presently pending in the Application.

Claims 6 and 23 are rewritten as independent claims. These are not narrowing amendments.

Claims 4, 7-9, 11, 16, 18, 19 and 24-26 are amended such that they recite clearly the features presented thereby.

### ***Formal Matters***

Applicant thanks the Examiner for acknowledging the claim for foreign priority and the receipt of the priority document.

Further, Applicant thanks the Examiner for reviewing and considering the references cited in the Information Disclosure Statements.

### ***Rejection of Claims 1-3, 6-10, 13-15, 19, 20 and 22-24 under 35 U.S.C. § 102(e)***

The Examiner rejected claims 1-3, 6-10, 13-15, 19, 20 and 22-24 under 35 U.S.C. § 102(e) as being anticipated by Rinne et al., U.S. Patent No. 6,574,473. This rejection is traversed.

Independent claims 2 and 22 are cancelled without prejudice or disclaimer, therefore the rejection is moot with respect to these claims.

Among the problems recognized and solved by Applicant's claimed

invention is that of selecting a new network for a handover process during a session based on a preference for a network stored by user equipment, such as a mobile terminal. (This discussion merely illustrates some aspects of Applicant's claimed invention; not every embodiment of Applicant's invention necessarily embodies or provides the features discussed herein.) According to an aspect of Applicant's claimed invention, for a handover process, a preference for a mobile network may be stored by the user equipment, such as, for example, by a mobile terminal, and the preferred network may be selected from the available networks based on the preference information stored by the user equipment.

For at least the following reasons, Applicant's invention is neither anticipated by, nor rendered obvious from, the prior art. Claim 1 requires, *inter alia*, providing neighbor cell information for the at least one other preferred network to the User Equipment, the at least one preferred other network signaled to the active network from the User Equipment.

Rinne discloses a method and system for controlling a radio communications network and a radio network controller in such networks. Rinne discloses communicating information about base stations from a radio network controller (RNC) to another RNC during handover between radio networks. Rinne is silent on radio network preferences. Rinne is concerned with providing information to the "new" RNC during a handover in a macrodiversity combining technique environment. (Rinne, Col. 4, lines 11-17.) A macrodiversity combining technique environment is one in which more than one base station (BS) is active in providing data down stream to a mobile station. In particular, Rinne discloses that after handover from an old RNC to a "new" RNC (both

the old and new RNC's being inside the same network, Rinne column 4, lines 33-36, or in different networks), information about the active base stations (active in the macrodiversity combining technique environment) is provided to the new RNC. Also, Rinne discloses an "anchor RNC," active also when the "active" RNC is active (Rinne, column 4, lines 40-49); and discloses that a list of base stations that would constitute a candidate set (CS) of base stations in case the neighboring RNC becomes the active RNC, is transmitted to the new RNC.

Rinne does not identify or suggest the problem of selecting among the available networks. Clearly, Rinne does not disclose or suggest selecting a preferred network based on the preference information signaled from the User Equipment. Further, Rinne does not disclose or suggest providing neighbor cell information to the User Equipment. That is, since Rinne does not discuss the problem of selecting a network, Rinne is incapable of disclosing or suggesting selecting a preference network based on preference information, let alone signaling the same from the User Equipment. In fact, Rinne belongs to the prior art recognized by Applicant's disclosure, because Rinne does not identify the problems solved by Applicant's claimed invention, let alone disclose or suggest the solutions provided by Applicant's claimed invention.

The Examiner cites column 7, lines 56-65 discussing Figure 6b of Rinne, and alleges that Rinne discloses selecting among the available networks based on preference information. Figure 6 shows a flow diagram of a method for handover involving RNC to RNC transmission of base station information. Step 624, cited by the Examiner, discusses a fixed connection set up between the RNC [j] and base stations BS [a(j)...f(j)]. Thereafter radio connections are set up between the RNC [j] and a mobile

station (MS) [α], early links are established between base stations BS [a(j...f(j)] and mobile stations (MS) [α], and a handover is executed between RNC [i] and RNC [j] (Step 626). Rinne does not disclose or suggest selecting a network based on a network preference information, as *inter alia*, claimed in claim 1. Therefore, Rinne does not disclose or suggest the recitations of claim 1.

Claims 13-15 depend from independent claim 1, and thus incorporate the novel and non-obvious features thereof. Therefore, claims 13-15 are patently distinguishable over the prior art for at least the reasons that independent claim 1 is patently distinguishable over the prior art.

Independent claim 3 requires, *inter alia*, receiving from User Equipment an indication of at least one preferred other network. In addition, claim 3 requires, *inter alia*, providing neighbor cell information for the at least one preferred other network. Further, claim 9 requires, *inter alia*, User Equipment signaling to the active network a preferred other network for handover. Moreover, claim 19 requires, *inter alia*, a User Equipment comprising means for signaling a preferred other network to the active network.

As discussed, Rinne does not disclose or suggest a preferred other network provided to the active network or received from the User Equipment. Further, with respect to claim 3, Rinne does not disclose providing neighbor cell information for the preferred other network in response to the receiving of the indication of the preferred network. Therefore, Rinne does not disclose or suggest the recitations of independent claims 3, 9 and 19.

Claims 10 and 20 depend from independent claims 9 and 19, respectively,

and are patentably distinguishable over the prior art for at least the reasons that claims 9 and 19 are patentably distinguishable over the prior art.

Claims 6, 23 and 24 require, *inter alia*, sending a message to the User Equipment with information for incrementally adding to or subtracting from the list available networks. Further, claim 7 requires, *inter alia*, providing to User Equipment a message containing information for incrementally adding to or subtracting from a stored list of available networks. Moreover, claim 8 requires *inter alia* incrementally adding to or subtracting from a stored list of available networks.

As discussed, Rinne does not disclose maintaining a list of available networks. Therefore, Rinne is incapable of disclosing or suggesting sending a message to increment or subtract from such a list. Accordingly, Rinne does not disclose or suggest the recitations of claims 6, 7, 8, 23 and 24.

***Rejection of Claims 4 and 18 under 35 U.S.C. § 102(e)***

Claims 4 and 18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Whinnett, G.B. Patent No. 2,289,191. This rejection is traversed.

Independent claims 4 and 18 require, *inter alia*, transmitting from the User Equipment an indication of a preference for a network. (Please see the attached Appendix for the proposed Amended text of claim 4; we propose amending claim 18 similar in concept to claim 4.)

Whinnett discloses determining handover between different communications systems, including cellular, cordless, wireless PABX, the handover

performed by accessing a bulletin board of likely new systems to which to handover a connection. Whinnett does not disclose or suggest that a User Equipment transmits an indication of a preference for a network, as *inter alia*, required by independent claims 4 and 18. Therefore, Whinnett does not disclose or suggest the recitations of claims 4 and 18.

***Rejection of Claims 11, 12 and 25-27 are rejected under 35 U.S.C. § 102(e)***

Claims 11, 12 and 25-27 are rejected under 35 U.S.C. § 102(e) as being obvious over Korpela et al., U.S. Patent No. 6,510,146. This rejection is traversed.

Independent claim 11 and 26 require, *inter alia*, network preferences information communicated by the User Equipment. Further, independent claim 25 requires, *inter alia*, receiving from User Equipment an indication of a preferred other network. Korpela discloses a method for handover and cell selection. In particular, Korpela discloses that: (1) the mobile station selects a group of most advantageous new cells based on signal measurement; (2) the BS maintains a list of those surrounding BSs to a cell of which it can handoff in the near future; (3) the BS may be of UMTS network cells or GSM or DCS1800 cells, such that a mobile station that cannot operate in the cells of a certain other system can simply ignore the descriptions concerning the cells of such systems.

Korpela does not disclose or suggest that the User Equipment communicates network preference information. Korpela is concerned with selection of best cells for handover, and not with the selection of networks based on preference data.

According to Korpela, if a handover is to a cell that happens to be of a different network, then the handover is based on the selection of the most advantageous cell based on the measurement performed by the mobile station of signal strength of the suitable new cell. That is, when the best cell selected in this way for handover happens to be of a network in which a mobile station cannot operate, then such cells are ignored.

However, Korpela does not disclose or suggest that network preference information is communicated by the User Equipment, as *inter alia* required by claims 11 and 26. Further, Korpela does not disclose or suggest receiving from User Equipment an indication of a preferred other network, as *inter alia*, required by claim 25. Therefore, Korpela does not disclose or suggest the recitations of independent claims 11, 25 and 26.

Claim 12 depends from independent claim 11, and claim 27 depends from independent claim 26. Therefore, claims 12 and 27 incorporate the novel and nonobvious features of their respective base claims and are patently distinguishable over the prior art for at least the reasons that independent claims 11 and 26 are patently distinguishable over the prior art.

***Claims 16 and 17 are rejected under 35 U.S.C. § 102(e)***

Claims 16 and 17 are rejected under 35 U.S.C. § 102(e), as being anticipated by Bodin, U.S. Patent No. 6,387,027. This rejection is traversed.

Claim 16 requires, *inter alia*, transmitting from the User Equipment an indication of a preference for a network.

Bodin discloses a mobile station that avoids repeated rejection from a

mobile network by deleting non-allowable networks from a list of mobile networks stored in its memory. Bodin does not disclose or suggest transmitting from the User Equipment an indication of a preference for a network. Therefore, Bodin, does not disclose or suggest the recitations of independent claim 16.

Claim 17 depends from independent claim 16, and is thus patently distinguishable over the prior art for at least the reasons that independent claim 16 is patently distinguishable over the prior art.

***Rejection of Claim 5 under 35 U.S.C. § 103***

Claim 5 is rejected under 35 U.S.C. § 103, as obvious from Whinnett and Rinne. This rejection is traversed.

Claim 5 depends from independent claim 4. Rinne does not remedy the deficiencies of Whinnett as they relate to Applicant's invention as claimed in claim 4. Therefore, claim 5 is patently distinguishable over the prior art for at least the reasons that independent claim 4 is patently distinguishable over the prior art.

***Rejection of Claim 21 under 35 U.S.C. § 103***

Claim 21 is rejected under 35 U.S.C. § 103, as obvious from Bodin and Gourgue et al., U.S. Patent No. 6,584,116. This rejection is traversed.

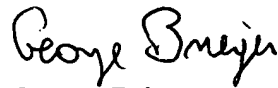
Claim 21 depends from independent claim 16. Gource discloses a UMTS mobile telephone network enabling preparation for handover to a GSM cell during a call. Gource does not remedy the deficiencies of Bodin as they relate to claim 16. Therefore,



claim 21 is patently distinguishable over the prior art for at least the reasons that claim 16 is patently distinguishable over the prior art.

In view of the foregoing discussion, the Application is now believed to be allowable and the Examiner is respectfully requested to reconsider the rejections and allow the Application. Should the Examiner have any questions about the within amendment or about the Application more generally, the Examiner is invited to telephone the undersigned attorney at the telephone number listed below.

Respectfully submitted,



George Brieger  
Registration No. 52,652

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343 Ext. 503

GB:eg